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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,820

08/20/2008

John Vivian Woodley

A-10084

7403

20741

7590

09/28/2011

Welsh Flaxman & Gitler  
2000 Duke Street , Suite 100  
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EXAMINER

WEBB, SARAH K

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

09/28/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,820	<b>Applicant(s)</b> WOODLEY, JOHN VIVIAN	
	<b>Examiner</b> SARAH WEBB	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) ☒ Claim(s) 1-3,5-7,9 and 11 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-3,5-7,9 and 11 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/28/2011 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 7/28/2011 have been fully considered but they are not persuasive. Applicant argues that the Fujihara and LeVine references fail to disclose the specific locations of pressure points on the mask that correspond with known acupressure points on the wearer's face at locations ST2, ST3, and GV24.5, as recited in claim 1. The claim limitations directed towards the location of the pressure points of the mask relative to the acupressure points on the wearer's face are considered to be limitations directed towards the intended use of the device, since the acupressure points are located on the wearer's face and are not structural features of the claimed device. The prior art is not required to disclose the specific placement of the pressure points of the mask over the acupressure points ST2, ST3, and GV24.5 of the wearer's face, but have the *capability* of being used in this way.

While Fujihara and LeVine fail to specifically state that the ST2, ST3, and GV24.5 acupressure points are contacted by a pressure point on the mask, both references disclose a mask with pressure points located between the eyes and below the eye apertures. Fujihara discloses a plurality of pressure points located below the eye apertures and LeVine discloses a plurality of apertures located below the eye apertures in which the pressure points may be inserted. The modified Fujihara mask is *capable of* accommodating pressure points in a plurality of apertures, so that the precise location of the pressure points may be adjusted for each wearer.

The location of the pressure points on the mask overlying specific acupressure points on the wearer's face depends on variables including the alignment of the pressure points of the mask relative to the wearer's face and the particular wearer's anatomy. The anatomy of individual wearers' faces varies widely and the pressure points of the mask may contact each wearer in different locations. The pressure points of the modified Fujihara mask are *capable of* being placed in apertures between the eye openings to correspond with the GV24.5 acupressure point of the wearer's face. Two pressure points are capable of being placed in apertures below each eye aperture to correspond with the ST2 and ST3 acupressure points of the wearer's face. Since the modified Fujihara device includes all the structural requirements and *capable of* performing the intended functions, the device meets the claim requirements.

3. Applicant also argues on page 8 that the claimed invention is distinguished from the prior art of record, because the apertures of Applicant's mask are limited to specific regions. The claimed invention is not limited to apertures *only* in regions overlying the

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specified pressure points, as the term "comprising" is open ended. Therefore, the prior art may include features in addition to the claimed groups of apertures.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 5-7, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "acupuncture areas" in line 12. There is insufficient antecedent basis for this limitation in the claim. Since claims 2, 3, 5-7, and 9 depend from claim 1 and include all of its limitations, these claims are indefinite for the same reason.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-7, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 63-166235 (Fujihara) in view of US Patent No. 3,279,468 (Le Vine).

Fujihara discloses a mask for securing to a person's face that includes a plurality of non-compressible, non-conductive passive pressure points (1) on the skin contacting

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surface of the mask. The mask includes two eye apertures (2) and regions for covering the wearer's nose and cheekbones. The plurality of pressure points (1) are located in clusters below and between the eye apertures (2). As shown in Figure 2, the pressure points have a rounded, skin contacting surface.

Fujihara fails to configure the pressure points (1) to be selectively removable and attachable to the mask through plurality of open apertures located at known pressure points, but Fujihara does disclose another plurality of pressure points (5) (see Figure 3) that are selectively inserted into apertures (3). Le Vine discloses a therapeutic mask with pressure points (33) that are selectively removable and attachable to the mask through apertures (39) that are arranged in groups near known acupressure points. Similar to the placement of pressure points of the Fujihara mask, LeVine includes one group of apertures located between the eye openings and a group of apertures located under each eye opening of the mask. This arrangement provides a means for adjusting the position of the pressures points to accommodate variations in the faces of different wearers (column 9, lines 33-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Fujihara device so that all of the pressure points are selectively removable and attachable to the mask through groups of apertures, as taught by Le Vine, in order to provide an acupressure device that is capable of being adjusted to an individual's face. It would have been further obvious to place groups of apertures between the eye openings and under each eye opening, as disclosed by LeVine.

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Regarding claim 1: The limitations regarding the specific acupressure points ST2, ST3, GV24.5 to be contacted by pressure points on the mask are considered to be recitations of intended use of the device, since these points are located on a person's face and not on the claimed device. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*. The prior art is not required to disclose the specific placement of the pressure points of the mask over the acupressure points ST2, ST3, and GV24.5 of the wearer's face, but have the *capability* of being used in this way. While Fujihara and LeVine fail to specifically state that the ST2, ST3, and GV24.5 acupressure points are contacted by a pressure point on the mask, the modified Fujihara mask includes a plurality of apertures located between and below the eye apertures in which the pressure points may be inserted. A pressure point of the modified Fujihara mask is *capable of* being placed in apertures between the eye openings to correspond with the GV24.5 acupressure point of the wearer's face. Two pressure points are capable of being placed in apertures below each eye aperture to correspond with the ST2 and ST3 acupressure points of the wearer's face. This meets the requirements of pressure points coinciding with the five acupressure areas recited in claim 1. Since the modified Fujihara device includes all the structural requirements and *capable of* performing the intended functions, the device meets the claim requirements.

Regarding claims 3 and 7: Although Fujihara fails to disclose the material of the mask, LeVine teaches that the mask (22) should be made of a resilient material, such

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as polypropylene, to provide sufficient flexibility to conform to a variety of faces (column 7, lines 30-38). In light of LeVine's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the modified Fujihara device so that it is sufficiently flexible to conform to various faces. The term "moulded" is a product-by-process limitation that is not given full patentable weight. The process by which an article is made is not germane to the issue of patentability of the device itself. Nonetheless, LeVine discloses that the mask is molded (column 7, lines 30-38).

Regarding claim 5, the modified Fujihara mask includes three groups of open apertures corresponding to three different acupressure points of the wearer's face, as discussed above.

Regarding claim 6, both Fujihara and LeVine disclose mounting portions extending from the rear of the pressure points.

Regarding claim 11, the modified Fujihara mask includes three groups of apertures located between the eye openings and under each eye opening. Each group of apertures is capable of accommodating detachable pressure points that can be arranged to coincide with an acupressure points on the wearer's face. The limitations directed towards the relative location of the pressure points of the mask to the points on the wearer's face are considered to be directed towards the intended use of the device. The prior art is not required to disclose the placement of the pressure points over the specific pressure points, but have the *capability* of functioning in this way. The pressure points of the modified Fujihara mask are *capable of* being placed in apertures between and under each eye aperture. Since the modified mask has a group of apertures under



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each eye socket, two pressure points are capable of being placed under each eye socket so that one pressure point overlies the wearer's cheekbone. The modified Fujihara mask includes all of the claimed structural features and is *capable of* being adjusted to coincide with the recited acupuncture points on the wearer's face, so it meets all the claim requirements.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Webb whose telephone number is (571)272-5749. The examiner can normally be reached on Monday through Friday from 9:00 AM-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, ***please contact the examiner's supervisor, Tom Hughes, at (571) 272-4357.*** The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

***If there are any inquiries that are not being addressed by first contacting the Examiner or the Supervisor, you may send an email inquiry to***

TC3700\_Workgroup\_D\_Inquiries@uspto.gov.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SARAH WEBB/  
Examiner, Art Unit 3731